

REMARKS

Reconsideration and allowance of the present application based on the foregoing amendments the following remarks are respectfully requested.

Status of Claims

Claims 61-68 are currently pending in the present application. Claims 61-66 stand rejected, and claims 67 and 68 are newly added.

Also, by this amendment, independent claim 53 and its dependent claims 55 and 60 have been cancelled. At the same time, independent claim 61 is being broadened in certain respects. By these changes, the Applicant is attempting to simplify the issues in prosecution by having a single generic independent claim, rather than two independent claims of overlapping scope. Thus, the cancellation of claim 52 should not be taken as surrendering the subject matter claimed therein.

Prior Art Rejections

Independent claim 61 stands rejected as being obvious over Mitsubishi in view of Akiya. In view of the clarifying amendments made to claim 61 and the following distinguishing remarks, the Applicant requests the Examiner to reconsider and withdraw this rejection.

Independent claim 61 recites an image transfer carrier comprising: (1) “a backing sheet,” and (2) “an image transfer layer comprising polymethylpentene, the image transfer layer being applied directly on the backing sheet to provide a surface onto which a toner image can be formed with the toner fusing with portions of the image transfer layer.” To more clearly emphasize the structural characteristics of the claimed invention, the layer

comprising the polymethylpentene has been labeled by this amendment as an “image transfer layer,” and it has also been characterized as providing “a surface onto which a toner image can be formed with the toner fusing with portions of the image transfer layer.” For example, the toner image could be formed by a printer or xerography machine, either directly on the surface of the image transfer layer, or on another carrier that is then used to transfer the image to the image transfer layer.

Further, directly applying the image transfer layer to the backing sheet allows the layer to release effectively when performing a subsequent image transfer operation. This is reflected by the claim language reciting “the direct application of the image transfer layer to the backing sheet facilitating release of the portions of the image transfer layer with toner fused therewith to a target object in an image transfer operation wherein the carrier is heated and pressed against the target object and then removed therefrom to leave the portions of the image transfer layer with the toner fused therewith on the target object.”

As discussed in the previous amendment, this structural arrangement defines the invention over the prior art, and renders it highly effective for use in image transfer operations. As discussed extensively in the patent specification, the use of polymethylpentene (“PMP”) in the image transfer layer is highly advantageous because it fuses with the printed image and portions of it will transfer off with the image, thus providing a high quality image on the target article. To ensure that the PMP image transfer layer is uncontaminated and can be effectively transferred off with the image, the invention of claim 61 is structured such that the PMP image transfer layer is provided directly on the backing sheet. This means that there is no intervening anchor or adhesive layer provided to secure the PMP image transfer layer to the backing sheet. If an anchor or adhesive layer were used, that layer would migrate into the PMP image transfer layer during formation, thus contaminating

at least part of the PMP image transfer layer. Because an anchor or adhesive layer is designed to secure the PMP image transfer layer to its backing sheet, its properties would be such that it would have a bonding characteristic that would inhibit the PMP image transfer layer from coming off with image being transferred. At the very least, the migration of an anchor layer into the PMP image transfer layer runs the risk of detracting from its image quality characteristics. As such, to ensure the purity of the PMP layer or coating, the Applicant has invented the construction of claim 61 with the PMP image transfer layer being applied directly on the backing sheet such that there is no intervening layer that could interfere with the image transfer performance of the PMP image transfer layer.

The Examiner asserts that Mitsubishi discloses the claimed invention because the use of an anchor layer between its backing sheet and its PMP print receiving layer “is deemed optional.” Official Action of November 24, 2003 at 2. Specifically, the Examiner states:

The use of an anchor layer is deemed optional by Mitsubishi. Hence, Mitsubishi clearly contemplate[s] the application of PMP directly to the support. The process argument that the Mitsubishi article is not intended for use as transfer material is not dispositive of the issue of the patentability of the present article claims. Id.

The Applicant respectfully disagrees with the Examiner’s assertion that Mitsubishi discloses the invention of claim 61. In particular, the Applicant disagrees with the Examiner’s assertion that Mitsubishi “clearly contemplate[s] the application of PMP directly to the support.”

First, Mitsubishi does not disclose a single embodiment that has its PMP print receiving layer coated directly on its backing sheet. Instead, every embodiment in Mitsubishi includes an anchor or adhesive layer on the side of the backing sheet that receives the PMP print receiving layer. No embodiment is disclosed that meets the direct application limitation of claim 61.

Second, nowhere does Mitsubishi ever explicitly disclose that its invention could be practiced with the anchor or adhesive layer omitted and the PMP print receiving layer being applied directly on the backing sheet. A close review of Mitsubishi reveals that it never states that its PMP print receiving layer is applied directly to its backing sheet. Moreover, the Examiner has not cited to any passage in Mitsubishi providing such a disclosure.

Third, to the best the Applicant can understand the Examiner's conclusory rejection, it appears that the Examiner is relying inappropriately on a theory of inherency to support his anticipation rejection. For a prior art reference to anticipate a claim by inherency, the Examiner must prove that the undescribed claim limitation "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities." Id. at 1269.

At most, Mitsubishi says that the invention therein "may" use an anchor or adhesive layer. However, the Applicant submits that this does not inherently disclose that the Mitsubishi invention is practiced with its PMP print receiving layer directly applied to its backing sheet.

The full language in this respect is stated on page 12 of the previously filed translation of Mitsubishi, wherein it states:

To ensure tight adhesion between the base paper and polymethylpentene resin layer, an anchor coating layer or an adhesive layer may be between the base paper and the polymethylpentene resin layer.

This language does not inherently disclose that the PMP layer is applied directly on the backing sheet. Instead, the use of the permissive word "may" could be read as suggesting an option between the "anchor coating layer" and the "adhesive layer," or as suggesting that

some other layer could be used, rather than as necessarily suggesting that these layers could be omitted entirely. Moreover, in the context of Mitsubishi in its entirety, the Applicant submits that one skilled in the art would not understand this language as necessarily suggesting that the PMP layer could be applied directly on the backing sheet. Mitsubishi clearly states the advantage of using either an anchor layer or an adhesive layer as ensuring “tight adhesion.” Translation of Mitsubishi at 12. Further, each and every embodiment is disclosed as having one of these layers between the PMP print receiving layer and the backing sheet. Thus, the Applicant submits that the Examiner cannot assert that Mitsubishi inherently discloses a PMP layer directly applied to a backing sheet.

In support of the Applicant’s position, the Examiner’s attention is drawn to two Federal Circuit cases: In re Spada, 911 F.2d 705 (Fed. Cir. 1990), and Rowe v. Dror, 112 F.3d 473 (Fed. Cir. 1997).

In re Spada specifically states that to establish anticipation, “the reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it.” 911 F.2d at 708. With respect to claim 61, the Applicant submits that Mitsubishi would not place one of ordinary skill in possession of the claimed image transfer carrier with a PMP image transfer layer applied directly to a backing sheet, wherein this direct application facilitates release of portions of the PMP image transfer layer during an image transfer operation. To the contrary, the Applicant submits that, as discussed above, Mitsubishi’s disclosure only evidences that it is in possession of a construction with “tight adhesion” achieved by using an anchor or adhesive layer, which would not suggest an ability to release the PMP layer for image transfer in the manner defined in claim 61.

Rowe v. Dror addresses a situation wherein the claim limitation at issue recited a “balloon angioplasty catheter,” and the prior art reference disclosed a general purpose balloon catheter. In finding that the use of the term angioplasty distinguished the claim, the Federal Circuit states:

In fact, [the prior art reference] makes no suggestion of any kind about its structural suitability for angioplasty procedures. About the most that can be said for the [prior art reference] is that it does not explicitly describe anything inconsistent with angioplasty procedures. However, this negative pregnant is not enough to show anticipation. 112 F.3d at 480.

Here with respect to claim 61, it appears that the Examiner is relying on Mitsubishi, which only shows a general printing paper, to arrive at an anticipation of claim 61, which specifically defines a structure especially designed for image transfer. Thus, similarly to the facts in Rowe v. Dror, the Examiner here is attempting to use the more generalized structure of the Mitsubishi printing paper and rely on that as an anticipation of the claimed carrier that is designed for use in image transfer by virtue of directly coating the PMP layer on the backing sheet. Indeed, the facts of the present case are even more compelling because in Rowe v. Dror, the Court found that the fact that the prior art was not inconsistent with the claimed invention was insufficient to establish anticipation. Here, Mitsubishi actually contains disclosure that is inconsistent with claim 61 because it teaches providing an anchor or adhesive layer between its backing sheet and PMP layer, whereas claim 61 does the opposite by applying its PMP layer directly to its backing sheet.

Akiya does not supply the teachings discussed above that are lacking from Mitsubishi.

Accordingly, for at least the foregoing reasons, claim 61 is submitted to be patentably distinguishable over the art of record, and the Examiner is requested to withdraw the outstanding rejection against the same.

Claims 62-68 depend from claim 61 and are submitted to be patentable based on such dependency. These claims are also submitted to be patentable for reciting further separately patentable features.

Section 112 Rejections

The foregoing amendments to the claims are submitted to resolve the outstanding §112, ¶2 rejections in a self-explanatory manner. Therefore, withdrawal of these rejections is respectfully requested.

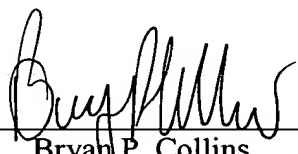
Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly requested.

If the Examiner has any questions concerning this response, or the application in general, he is encouraged to contact the undersigned at the below-listed telephone number to help facilitate prosecution of this application.

Respectfully submitted,

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